



ZJW
HF

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Robert S. HAMILTON

Group Art Unit: 2674

Application No.: 09/683,531

Examiner: K. NGUYEN

Filed: January 16, 2002

Docket No.: 106472

For: E-PAPER LABELS ON RECORDABLE/REMOVABLE MEDIA WITH OPTICAL DATA LINK AND OPTICAL POWER SUPPLY

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following comments are directed to the points of arguments and comments raised in the Examiner's Answer mailed October 13, 2005.

I. Grouping of Claims

It is alleged in the Examiner's Answer, at page 2, item (7) that "the rejection of claims 1-18 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 C.F.R. §1.192(c)(7)." Applicants remind the Examiner that 37 C.F.R. §1.92 no longer exists and does not control practice before the Board of Patent Appeals and Interferences. Rather, new §41 controls these procedures. Additionally, a separate statement of the grouping of claims for appeal is no longer required. Instead, the claims are argued with respect to each ground of rejection, based on the claims subject to that ground of rejection.

See §41.37(c)(1)(vi), (vii). As Appellant's Appeal Brief correctly meets each and every requirement set forth in 37 C.F.R. §41 pertaining to the requirements of an Appeal Brief, Appellant's Appeal Brief complies with the rules as currently provided.

II. **Claim Rejections Under 37 C.F.R. §103**

A. **Bloch Fails to Disclose or Suggest the Features as Alleged**

It is alleged in the Examiner's Answer that Bloch teaches all of the features recited in independent claims 1, 9, 10 and 18 except for a bistable display device. In an effort to overcome the admitted deficiency, Albert is combined with Bloch for allegedly providing such a bistable device.

For example, it is alleged at page 3 of the Examiner's Answer that Bloch teaches a display label, comprising an energy source that generates an operating signal; an embedded optical data link for bi-directional communication with a recording/play device; and a microcontroller that receives the operating signal generated by the energy source and a signal from the optical data link and provides a control signal to the bistable display device so that an image is generated on the label of the recording media, wherein the label is automatically updated by the recording/play device.

However, Bloch fails to disclose any such label. Rather, Bloch specifically recites that "the present invention utilizes a specially-designed floppy disk housing along with additional circuitry added to the personal computer which accesses the floppy disk (e.g., a modified floppy disk drive) to automatically update a programmable dynamic display means" (col. 3, lines 25-29 of Bloch) (emphasis added).

Bloch further describes the invention as including a memory, and a liquid crystal device (LCD) display secured to the specially-designed floppy disk housing. Bloch also describes a disk terminal strip 112 and a battery 116 also residing on the floppy disk housing. Thus, in contrast to the label having the components recited in the rejected claims, Bloch

teaches a specially-designed floppy disk housing which houses the components recited in Bloch. Accordingly, Bloch fails to disclose a display label as recited in the rejected claims.

Although the Final Rejection and the Examiner's Answer each allege that Bloch teaches a label comprising the components recited in the rejected claims, no support is provided for the allegation. Furthermore, as Bloch clearly recites that it is the floppy disk housing which comprises the components, Bloch fails to disclose the features as alleged in the Office Action.

It is to be noted that in a second embodiment of the Bloch invention, the memory and battery are disposed internal to the storage device housing. Accordingly, this embodiment also fails to disclose the features recited in the rejected claims.

Regarding independent claims 9 and 18, it is alleged in the Examiner's Answer that Bloch discloses "user configurable pattern electrodes affixed to a portion of the bistable device, the pattern electrodes receiving the control signal from the controller and applying an electric field across the user selected portions of a display device." However, Bloch discloses no such feature. Rather, Bloch recites that a programmable, dynamic display device which is located on the floppy disk housing is "updated transparent to the user" (col. 3, lines 8-10) (emphasis added). Accordingly, in contrast to "user configurable pattern electrodes", Bloch clearly contemplates configuration of the electrodes that are updated transparent to the user, i.e., not user configurable. Thus, Bloch fails to disclose the features as alleged.

B. Albert Fails to Overcome the Deficiencies of Bloch

Although Albert teaches a printable display comprising an encapsulated electrophoretic display medium, Albert fails to overcome the deficiencies of Bloch. For example, Albert does not disclose or suggest an addressable display usable as a label for a recordable media, the label including an embedded optical link for bi-directional communication with a recording/play device and a controller that receives the operating

signal generated by the energy source, as recited in the rejected claims. Additionally, because Albert fails to disclose or suggest such a feature, there is no motivation to make the combination as proposed in the final rejection.

In rejecting claims under 35 U.S.C. §103 it is incumbent on the Examiner to establish factual bases to support the legal conclusion of obviousness. See, *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In doing so, the Examiner must provide the actual determinations as set forth in *Graham v. John Deere Co.*, 383 US 1, 17, 148 USPQ 759, 767 (1966). The criteria set forth in *Graham* include (1) some suggestion or motivation either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the teachings; (2) a reasonable expectation of success; and (3) the combination must teach or suggest all of the claimed features. These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

As discussed above, as Albert does not disclose or suggest an addressable display usable as a label for recordable media, the label including an embedded optical link for bi-directional communication with a recording/play device in a controller that receives the operating signal generated by the energy source, there is no suggestion or motivation to make the combination. Therefore, the first criterion set forth in *Graham* has not been met.

It has been held that if a reference's disclosure relates to the same problem as the claimed invention, that fact supports the use of the reference in an obviousness rejection. *In re Clay*, 956 F.2d 656, 659 (Fed. Cir. 1992). The problem being addressed in the Albert reference relates to problems that are inherent in liquid crystal alignment in TM and STM displays including stresses that can cause changes in the scattering or absorbance of PDLC and cholesteric films. In contrast to the problems being addressed in Albert, the subject

matter of this application, relates to problems found using paper with electronically addressable recording media. Thus, because the applied reference of Albert relates to a problem different from that of the claimed invention, there is no support for the use of the reference in an obviousness rejection.

In making an assessment of the differences between the prior art and the claimed subject matter, §103 specifically requires consideration of the claimed invention "as a whole." The "as a whole" instruction prevents evaluation of the invention on a part-by-part basis. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior components. *In re Ruiz v. A.B. Chance Co.*, 357 F.2d 1270, 1275 (Fed. Cir. 2004). The "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

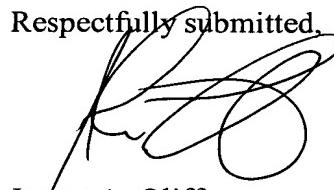
Because there is no motivation or suggestion to make the combination, and because the reference is addressing a problem different from that of this application, the references are not being considered as a whole. Rather, it appears that the references are being evaluated on a part-by-part basis in an effort to provide a component admitted as being deficient in the primary reference. Thus, combining the teachings of Albert with those of Bloch is improper as it merely imports hindsight into the line of reasoning without proper motivation or suggestion to make such a combination.

Even were such a combination made, merely combining the bistable device of Albert with the floppy disk housing of Bloch in replacement of the LCD display, would not provide

the advantages of the subject matter recited in the rejected claims of this application. For example, as discussed above, the device in Bloch requires that the components are disposed on the specially-designed floppy disk housing and are not part of a label. Therefore, even were the bistable device of Albert to be substituted for the liquid crystal display as taught by Bloch, the resulting combination would not be removable or transferable from the floppy disk housing without destruction of the "label". In contrast, the rejected claims recite that the components are part of the label, and therefore the label is easily removable from the recording medium without destruction resulting in obvious cost savings and benefits of retention of the content of the label, reuse, etc.

III. Conclusion

It is respectfully submitted that the remaining points of arguments set forth in the Examiner's Answer were fully addressed in the appellant's appeal brief. For at least the reasons set forth herein and in the appeal brief, it is respectfully submitted that claims 1-18 are in condition for allowance.

Respectfully submitted,


James A. Oliff
Registration No. 27,075

John W. Fitzpatrick
Registration No. 41,018

JAO:JWF/ldg

Date: December 6, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461
--